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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,279	01/24/2002	Yoshiharu Sasaki	Q68236	6321

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SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
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EXAMINER

NGUYEN, ANTHONY H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,279

Applicant(s)

SASAKI, YOSHIHARU

Examiner

Anthony H. Nguyen

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 24-51 is/are pending in the application.
- 4a) Of the above claim(s) 8-23 and 52-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 24-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election without traverse of Group I, Figures 5-9,24,25,27-29,32 and 36-43, and claims 1-7 and 24-51 filed on December 23, 2004 is acknowledged.

Accordingly, claims 8-23 and are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "suction apparatus" (claims 1 line 7, claims 5,6 and 7, line 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Objections

Claims 1-7, and 35- 51 are objected to because in general the claims are a functional and narrative description of desired capabilities rather than positive recitation of structure or method. For examples, there is no proper antecedent basis for "the fixed surface" (claim 1 line 2, claims 5-7 line 3). Additionally, it is unclear which element the

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words "it" (claim 44, lines 6 and 7, claim 50 line 5) is referred to. The language "can be" (claim 50, line 5) is not a positive claim language. Claims 43-45 are functional and narrative description of desired capabilities rather than positive recitation of the steps for cleaning the recording medium fixing member. Also, the dependency of claim 50 is improper because it is improper to mix statutory classes of invention except for certain very limited cases such as product by process invention. With respect to claims 35-51, the scope of the claims is unclear since the preambles of the claims appear to recite a cleaning method of a recording medium or a foreign material removal method.

However, the steps are not cited, and the claims direct to the structure of a recording apparatus. Note that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the claims are treated as apparatus claims.

The above are simply examples of the errors present. Applicant is required to carefully review the claims and eliminate all such errors.

To the extent the claims are definite and a positive recitation of the structure, it appears that the following prior art rejection is proper.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 24-51 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Williams et al. (US 6,024,019) in view of Corrado et al. (US 6,196,128).

With respect to claims 1, 5-7, 24, 35, 43, 44, 45 and 50, Williams et al. teaches a recording apparatus having a recording head 320, a flexible plate 306 or 122, a recording medium fixing member 500 which includes a plurality of suction ports 506 which secure the flexible plate 306,122 and a cylinder cleaner 325 (Williams et al., Figs. 2, 8,11 and 12). Williams et al. does not teach the adhering roller which cleans the fixed surface of the recording medium fixing member. Corrado et al. teaches the adhering cleaning roller 40 which moves to or away from the surface of the roller 18 for cleaning as shown in Fig.1. In view of the teaching of Corrado et al. , it would have been obvious to one of ordinary skill in the art to modify the recording apparatus of Williams et al. by substituting the the adhering roller as taught by Corrado et al. to improve the efficiency of cleaning the fixed surface of a recording medium fixing

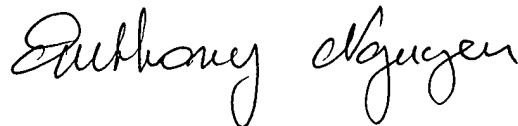
Conclusion

The patents to Schultz, Capdeboscq, and Korbonski et al. are cited to show other structures and method having obvious similarities to the claimed structure and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168.

The fax phone number for this Group is (703) 872-9306.



Anthony Nguyen
March 14, 2004
Patent Examiner
Technology Center 2800